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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/849,735	05/04/2001	John A. Blackman	WIS-3.2.009/3803	8085

7590

12/20/2002

COBRIN & GITTES
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EXAMINER

FRANCIS, FAYE

ART UNIT

PAPER NUMBER

3712

DATE MAILED: 12/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	09/849,735	BLACKMAN ET AL.	
	Examiner	Art Unit	
	Faye Francis	3712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 20-28 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-7 and 9-12 is/are allowed.
- 6) ☒ Claim(s) 20-24, 27 and 28 is/are rejected.
- 7) ☐ Claim(s) 25 and 26 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 May 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4</u> . | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

1. In response to the election made on 1/28/02 the previous restriction mailed on 10.28/02 is hereby withdrawn. Accordingly, claims 1-12 and 20-28 will be further examined on the merit.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the second distal portion coupled to the interior in claim 8, the rocker arm/sliding arm in claims 9 and 10, the shell having an interior portion in claim 20, the plurality of sheets having an edge and interior side in claim 23 and the tab extending through the valve in claim 28 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: proper antecedent basis should be provided in the specification for the phrase "the second distal portion coupled to the interior" in claim 8 and the phrase "rocker arm/sliding" in claims 9 and 10. Also, proper antecedent basis should be provided in the specification for the requirement in claim 11 that "the tab has an aperture which mates with a portion of the sliding arm" and for the requirement in

claim 12 that the tab is coupled to the sliding arm. Additionally, proper antecedent basis should be provided in the specification for the requirement in claim 28 that "the tab is arranged to extend through the valve and enables a manual change of the switch position".

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 8 and 28 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is not clear how the second distal portion is coupled to the interior and how the tab is arranged to extend through the valve and enables a manual change of the switch position as required in claim 8 and 28 respectively.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

7. Claims 8, 20-24 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 8: it is not clear what other distal portion is the applicant referring to and how is it coupled to the interior?

Claims 20-22 and 24 are indefinite since the claims appear to recite further limitations on the inflatable apparatus/device and the balloon respectively when no inflatable apparatus/device or balloon appear to have been positively recited in these claims or in the claims from which they depend.

Claims 20, 24 and 27 are indefinite because it is not clear how the word "automatically", is intended to further limit the device.

In view of the examples above, the applicant is required to carefully review all of the claims in order to correct those having the same defects but not specifically pointed to.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claim 22 is rejected under 35 U.S.C. 102(b) as being anticipated by Wang.

Wang discloses in Figs 1-4, an inflatable object [col 1 line 14], a shell [wall 20], a circuit means 70 and means [cap 80] coupled to the circuit means.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang.

Wang discloses in Figs 1-4, an inflatable object [col 1 line 14], a shell [wall 20], a circuit means 70, an energy source 62, a switch [col 1 line 33] electrically coupled to the energy source as recited in claim 20, a tab [cap 80] is arranged to change the switch position from the open circuit position to the closed circuit position as the inflatable apparatus is inflated [while the inflatable apparatus is inflated, a person can move the tab [cap] from the non-conducting position to a conducting position in order to change the switch position from the open circuit position to the closed circuit position actuating powering of the electronic module by the battery] as recited in claim 21.

Wang does not disclose the tab coupled between the shell and the circuit.

With respect to claim 21 the tab coupled between the shell and the circuit: changing the location of the tab from the proximate location shown by Wang to a location between the shell and the circuit, absent any criticality, is also considered an obvious modification of Wang's apparatus that a person having ordinary skill in the art at the time the invention was made would be able to provide using routine experimentation since the courts have held that there is no invention in shifting the position of a structure to a different position if the operation of the device would not be thereby modified. In re Japikse, 86 USPQ 70 (CCPA 1950).

12. Claims 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Margolis in view of Eagan.

Margolis discloses in Figs 1-5 (also see attachment at the end of this Office Action wherein the letters A-C have been added by the examiner), an inflatable balloon 30, a plurality of sheets [A and B] having an edge an interior side, a sound producing circuit 20, a battery 18, a switch 20, a noise generator [speaker 16] and a tab [patch 26] as recited in claim 21.

Margolis does not disclose plurality of batteries, piezoelectric noise generator and a sound producing circuit being mechanically coupled to the interior of one of the plurality of sheets.

Egan teaches a desirability to use piezoelectric buzzer noise generator as a speaker element to output sound from a sound chip [col 5 line 34]. It would have been obvious to one of ordinary skill in the art at the time the invention was made, in view of Egan to utilize a piezoelectric noise generator in a system as disclosed by Margolis in order to obtain a durable, inexpensive, light weight and high volume sounding device. Additionally, it would have been obvious to further provide the device of Margolis with plurality of batteries in order to generate additional power.

With respect to the sound producing circuit being mechanically coupled to the interior of one of the plurality of sheets: changing the location of the sound producing circuit from the proximate location shown by Margolis to a location interior of one of the plurality of sheets, absent any criticality, is also considered an obvious modification of Wang's apparatus that a person having ordinary skill in the art at the time the invention was made would be able to provide using routine experimentation since the courts have held that there is no invention in shifting the position of a structure to a different position

if the operation of the device would not be thereby modified. In re Japikse, 86 USPQ 70 (CCPA 1950).

Double Patenting

13. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

14. Claims 1-4 and 20-24 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of U.S. Patent No. 6,482,065, hereinafter US'065. Although the conflicting claims are not identical, they are not patentably distinct from each other because they set forth subject matters, which are obvious over each other and only differ in breadth of terminology used. For example, the limitation "a tab" Claims 1-4, 7 and 20-24 of the application is an obvious variation in meaning of the limitation "an insulator" in US'065 claims 1 and 2 because the tab and the insulator are disclosed as being the same feature.

Allowable Subject Matter

15. Claims 1-7 and 9-12 are allowed.

16. Claims 25-26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

17. Claim 8 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, first and second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

18. Claims 27-28 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, first or second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Faye Francis whose telephone number is 703-306-5941. The examiner can normally be reached on M-F 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 703-308-1745. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

FF
December 17, 2002

